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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,432	01/28/2002	Hirofumi Suda	B422-179	4288

26272 7590 01/23/2006

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EXAMINER

VIEAUX, GARY

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,432

Applicant(s)

SUDA, HIROFUMI

Examiner

Gary C. Vieaux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-10 is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 14, 2005 has been entered.

Amendment

In response to the Office Action dated July 28, 2005, claims 1, 4, 5, and 12 have been amended. Claims 2, 3, and 11 have been cancelled.

Response to Arguments

Applicant's arguments filed November 14, 2005 have been fully considered but they are not persuasive.

Regarding claim 1, Applicant submits that this independent claim has been amended to incorporate the features of previously allowed claim 6, and therefore, claim 1 and all claims dependent therefrom are allowable (Remarks, p. 7-9). The Examiner respectfully disagrees.

Claim 1, as currently amended, provides for "the play list data being **used for** controlling a reproducing process of the moving image stream recorded on the

recording medium so as to inhibit reproducing of the preceding moving image signal and the succeeding moving image signal, and reproduce the main moving image signal.” (Emphasis added.) (Amendment, p.3)

However, claim 6 provides “the play list data being **arranged to** controlling a
5 reproducing process of one moving image stream so as to inhibit reproducing of moving image signals of a first predetermined period from a head of the moving image stream to the recording start instruction and a second predetermined period from the recording stop instruction to an end of the moving image stream, and reproduce a moving image signal of a period other than the first and second predetermined periods in the moving
10 image stream, said recording means recording the play list generated by said generating means on the recording medium.” (Emphasis added.) (Amendment, p.4-5)

This distinction in amended language is critical, for the language of claim 1 pertains to a function of the play list data, as differentiated from the language of claim 6, which provides a structural limitation of the play list data. As to claim language that
15 discusses the use of the play list data, apparatus claims must be structurally distinguishable from the prior art, thus while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); MPEP § 2114. Therefore,
20 as amended claim 1 and previously allowed claim 6 do not claim the same features, it is maintained that the McKain reference in view of the Johnson reference continue to

teach the structural limitations of the apparatus of claim 1 (please see the 103(a) rejection to claim 1 infra.)

Regarding claims 4 and 5, each depend either directly from or indirectly from independent claim 1, and thus inherit all the limitations of independent claim 1.

- 5 Consequently, the Examiner respectfully upholds the 35 U.S.C. § 103(a) rejections to claims 4 and 5 based on their dependence and as they relate the foregoing response to arguments regarding claim 1.

Regarding claim 12, Applicant submits that there is no teaching in the McKain reference of generating a play list data according to the recording operation of the
10 moving image data and of updating the play list data in response to recording of a new image stream (Remarks, p. 9-10.) The Examiner respectfully disagrees.

The McKain reference is found to generate a play list data according to the recording operation of the moving image data by said recording means, in teaching that a clip is assigned a number as it is recorded (p. 15 Table I, p. 14 lines 13-16, p. 15 lines
15 1-4.) McKain is also found to update the play list data in response to recording of a new image stream by incrementing the number designating each clip recording and automatically organizing each clip in ascending order (p. 15 lines 1-4.)

Applicant also submits that there is no teaching or suggestion in the McKain reference of the play list data being used for controlling the reproducing process of the
20 moving image stream and updating the play list data so as to reproduce successively the main moving image data included in a plurality of moving image streams recorded

prior to the new moving image stream and the main moving image data included in the new moving image stream (Remarks, p. 10.) The Examiner respectfully disagrees.

To begin, regarding any claim language relating to the play list data being “used for”, please refer to response of claim 1 supra.

5 Next, as to said generating means updating the play list data so as to reproduce successively the main moving image data included in a plurality of moving image streams recorded prior to the new moving image stream and the main moving image data included in the new moving image stream, again, McKain is found to update the play list data by assigning an incremented clip number to the clip as it is recorded, with
10 the clips being automatically organized in ascending order (col. 15 lines 1-4.) McKain is also found to update this data so that image data is reproduced in successive order to that which has been recorded prior to the latest or current image data (p. 15 Table I.)

Based on the foregoing, the Examiner respectfully stands behind the 35 U.S.C. § 102(b) rejection to claim 12 as being anticipated by McKain et al. (WO 96/26600).

15

Claim Objections

Claim 1 is objected to because of the following informalities: there is insufficient antecedent basis for the limitation “said recording means” (Amendment, p. 3 ¶ 2.)

Claim 12 is objected to because of the following informalities: the term “stream”,
20 as in “a plurality of moving image stream” should be in the plural form (Amendment, p. 6 ¶ 6.)

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- 5 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by McKain et
10 al. (WO 96/26600).

Regarding claim 12, McKain teaches a recording apparatus comprising input means for inputting a moving image signal (fig. 1 indicator 22), instruction means for instructing a recording start and a recording stop (camera trigger, p. 23 lines 5-14), recording means for recording onto a recording medium a moving image stream
15 including main moving image data inputted in a period from the recording start instruction to the recording stop instruction (p. 9 line 32 – p. 10 line 4, p. 25 lines 28-32), and generating means for generating play list data according to the recording operation of the moving image data by said recording means, said generating means updating the play list data in response to recording of new moving image stream so as to reproduce
20 successively the main moving image data included in a plurality of moving image streams recorded on the recording medium prior to the new moving image stream and the main moving image data included in the new moving image stream (col. 15 lines 1-4, p. 15 Table I.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 **Claims 1 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over McKain et al. (WO 96/26600) in view of Johnson et al. (US 6,163,338.)

Regarding claim 1, McKain is found to teach an apparatus comprising input means (fig. 1 indicator 22), instruction means for instructing a recording start and a recording stop (camera trigger, p. 23 lines 5-14), a recording medium interface (p. 9 line 15 32 – p. 10 line 4) adapted to record on a recording medium (fig. 4 indicator 99) a period from the recording start instruction until the recording stop instruction, and a period before the start of recording which is appended to the succeeding data recorded based on a standard start operation (p. 25 lines 28-32), and generating means (p. 17 lines 9-10, indicating list generation; p. 15 Table I) for generating play list data according to the 20 recording operation of the moving image signal. However, McKain is not found to teach recording succeeding moving image data after a recording stop instruction.

Nevertheless, Johnson is found to further teach recording of data before and after a triggering event to provide additional information temporally related (col. 5 lines 39-50.) It would have been obvious for one of ordinary skill at the time of the invention 25 to include the concept of pre and post event recording as taught by Johnson, within the functionality of a recording apparatus, which already included pre-event recording, as

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taught by McKain, in order to create a recording apparatus that recorded image data immediately before a recording start designation, as well as immediately after a recording stop designation. One of ordinary skill in the art at the time of the invention would have been motivated to combine these teachings in order to allow for the acquisition of data related to, and in addition to, the data intentionally acquired during the originally determined recording period (from start instruction to stop instruction); data which may later be considered useful. One example of this usefulness would be applied to the case of an earthquake recording opportunity; in which a user did not trigger a recording start until after the initial indications of a recording opportunity began, such as when the user reacts to the start of an earthquake, and is followed by a triggered recording stop, only to find that the recording opportunity was not actually over, such as an aftershock of the earthquake.

As to the claim limitations in which the play list data being used for controlling a reproducing process of the moving image stream recorded on the recording medium so as to inhibit reproducing of the preceding moving image signal and the succeeding moving image signal, and reproduce the main moving image signal, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997.) The instant references teach the structural limitations of the apparatus as cited above, and therefore meet the claim limitations as recited.

Regarding claim 4, McKain and Johnson teach all the limitations of claim 1 (see the 103(a) rejection to claim 1 supra) including a teaching by McKain regarding an apparatus wherein said recording medium interface records the play list data generated by said generating means on the recording medium, said recording medium interface
5 reproducing the moving image stream according to the play list data recorded on the recording medium (p. 14 lines 14-16 and lines 20-21; col. 24 lines 16-32; p. 21 lines 26-27.)

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over McKain
10 et al. (WO 96/26600) in view of Johnson et al. (US 6,163,338), in further view of Matsui et al. (US 6,674,955.)

Regarding claim 5, McKain and Johnson teach all the limitations of claim 5 (see the 103(a) rejection to claim 4 supra), including teaching control means for controlling said recording medium interface and said image processing means so as to reproduce
15 the preceding moving image signal or the succeeding moving image signal from the recording medium ('600 – p. 7 lines 6-7; p.14 lines 13-19; p. 24 lines 22-23.) However, neither McKain nor Johnson are found to teach image processing means for executing effect processing on the moving image signal reproduced from the recording medium, or control means that execute effect processing for the reproduced preceding or
20 succeeding moving image signal according to effect reproducing designation.

Nevertheless, Matsui is found to teach an apparatus including image processing means for executing effect processing on reproduced moving image data (fig. 3

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indicator 3; col. 12 lines 9-12), and control means (fig. 4 indicator 3A; col. 13 lines 8-16, indicating control via CPU), wherein said control means controls a recording medium interface and said image processing means (col. 12 lines 18-26), so as to reproduce moving image signals that precede and succeed the designated moving image signal from the recording medium (col. 12 lines 23-26; col. 43 lines 44-52), and execute effect processing for the reproduced moving image signals according to effect reproducing designation (figs. 31B and 37B.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include the image processing means and effects as taught by Matsui, within the apparatus as taught by McKain and Johnson, in order to create an apparatus which not only reproduces successive moving image signals, but also includes transitional effects as a segue from one moving image signal to the next. It would further have been obvious to employ additional time, both preceding and succeeding the designated start and stop of the moving image signal, as provided above, in order to achieve the transitional effect without impinging on any of the operator designated range of the moving image signal; the transition coinciding with an already present predetermined time before a designated start of a moving image signal and concluding with an already present predetermined time after a designated stop of a moving image signal.

Allowable Subject Matter

Claims 6-10 are allowed.

Regarding amended independent claim 6, the prior art is not found to teach or fairly suggest, in combination with the existing elements of the present claim as

5 currently amended, play list data being arranged to control a reproducing process of one moving image stream so as to inhibit reproducing of moving image signals of a first predetermined period from a head of the moving image stream to the recording start instruction and a second predetermined period from the recording stop instruction to an end of the moving image stream, and reproduce a moving image signal of a period
10 other than the first and second predetermined periods in the moving image stream, said recording means recording the play list generated by said generating means on the recording medium.

Regarding claims 7-10, the prior art is not found to teach or fairly suggest, limitations of claim 6 from which dependence is derived (see claim 6 supra.)

15

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Vieaux whose telephone number is 571-272-7318. The examiner can normally be reached on Monday - Friday, 8:00am - 4:00pm.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NgocYen T. Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary C. Vieaux
Examiner
Art Unit 2612

10 Gcv2


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PRIMARY EXAMINER